

REMARKS

Claims 1, 14-21, 34, 44, 46 and 47 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the amendments and comments herein.

I. Rejection of Claims 1, 16, 34, 44, 46 and 47 Under 35 U.S.C. §102(b)

Claims 1, 16, 34, 44, 46 and 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gross (US Patent 5,555,346). Applicants' representative respectfully requests that this rejection be withdrawn for at least the following reasons. Gross does not disclose *adjusting decision making relating to the priority of subsequently received e-mails based on a user's interaction with prioritized e-mails*.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. (*Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002) (emphasis added). Moreover, the *identical invention must be shown in as complete detail as is contained in the ... claim*. (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)) (emphasis added).

Gross discloses a rule-based electronic messaging system. (*See* Gross at col. 1, ll. 11-12). The system triggers actions based on whether an event satisfies an IF-THEN rule or not. (*See* Gross at col. 2, ll. 42-51 and col. 4, ll. 40-53). One example of an event that can trigger an action is reading an email. (*See* Gross at col. 9, ll. 6-17). Examples of actions triggered by an event include moving an email to a folder specified by a user or auto-replying to an email. (*See* Gross at col. 10, ll. 63-65 and col. 11, ll. 6-15).

All of the claims recite the limitations *adjusting/adapting/altering/modifying decision making relating to the priority of subsequently received e-mails based on a user's interaction with at least some e-mails* or similar limitations. The Examiner contends that Gross discloses adjusting the priority of e-mails at col. 5, l. 25-col. 6, l. 57, col. 8, ll. 8-18, col. 9, ll. 26-52 and Figs. 3a-3h. Applicants' representative respectfully disagrees. Figs. 3a-3h and the cited sections of Gross merely show that an event triggers an action subject to an IF-THEN rule. Moreover, as the system of Gross is implemented using static IF-THEN rules, it is not configured to adjust its

decision making. In view of at least the foregoing, applicants' representative respectfully requests that this rejection be withdrawn.

II. Rejection of Claims 14, 17 and 18 Under 35 U.S.C. §103(a)

Claims 14, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gross and Nielsen (US Patent 6,337,699). Applicants' representative respectfully submits that this rejection should be withdrawn for at least the following reasons. Claims 14, 17 and 18 depend from claim 1 and as explained above, Gross does not teach or suggest all of the limitations of claim 1. Nielsen does not remedy the deficiencies of Gross. Thus, claims 14, 17 and 18 are not obvious over the combination of Gross and Nielsen and accordingly, this rejection should be withdrawn.

III. Rejection of Claim 15 Under 35 U.S.C. §103(a)

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gross, Nielsen, and Knowlton (US Patent 6,057,842). Applicants' representative respectfully submits that this rejection should be withdrawn for at least the following reasons. Claim 15 depends from claim 1 and as explained above, neither Gross nor Nielsen, alone or in combination, teach or suggest all of the limitations of claim 1. Knowlton does not remedy the deficiencies of Gross and Nielsen. Thus, claim 15 is not obvious over the combination of Gross, Nielsen and Knowlton and accordingly, this rejection should be withdrawn.

IV. Rejection of Claim 19 Under 35 U.S.C. §103(a)

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Gross and Nielsen, and Simonoff (US Patent 6,078,322). Applicants' representative respectfully submits that this rejection should be withdrawn for at least the following reasons. Claim 19 depends from claim 1 and as explained above, neither Gross nor Nielsen, alone or in combination, teach or suggest all of the limitations of claim 1. Simonoff does not remedy the deficiencies of Gross and Nielsen. Thus, claim 15 is not obvious over the combination of Gross, Nielsen and Simonoff and accordingly, this rejection should be withdrawn.

V. Rejection of Claims 20 and 21 Under 35 U.S.C. §103(a)

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gross in combination with Microsoft Outlook, America Online and Windows 95. Claims 20 and 21 depend from claim 1 and as explained above, Gross does not teach or suggest all of the limitations of claim 1. Microsoft Outlook, America Online and Windows 95 do not remedy the deficiencies of Gross. Thus, claims 20 and 21 are not obvious over the combination of Gross, Microsoft Outlook, America Online and/or Windows 95 and accordingly, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited. In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP248US]. Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731